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PATTERSON, THUENTE, SKAAR & CHRISTENSEN, L.L.C.  
US BANK BUILDING, SUITE 2000  
777 EAST WISCONSIN AVENUE  
MILWAUKEE, WI 53202

EXAMINER

CASIANO, ANGEL L

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/786,557

Applicant(s)

KOWALSKI ET AL.

Examiner

Angel L. Casiano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. This action is in response to application filed 25 May 2001.
2. Claims 1-14 are pending in the application.

### *Specification*

3. Applicant makes reference to two different titles for this application. Both "Chip Card Reader" and "Smart Card Reader" are used in the present application.
4. The titles for the invention that appear in the application are not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is well known that numerous smart card readers as well as chip card readers are available in the prior art. The title that applicant chooses for the present application should be descriptive.
5. Applicant claims benefit under 35 U.S.C. 119 (a)-(d). The reference information related to the claimed priority should be incorporated into the Specification, as part of page 1, line 1.
6. The disclosure is objected to because of the following informalities:  

Page 6, line 8; recites a standard frequency of 13,56 MHz.

Appropriate correction is required.

***Information Disclosure Statement***

7. The information disclosure statement (IDS) submitted is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites a “contact card activation command” in reference to claim 1. However claim 1 does not expose a “contact card activation command”. There is insufficient antecedent basis for this limitation.

Claim 13 recites, “returning to the inhibition state”. This claim makes reference to claim 1. Claim 1 does not recite or include an “inhibition state”.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3-7, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timson et al. [US 6,041,412] in view of Berger et al. [US 6,168,083 B1].

Regarding claim 1, Timson et al. teaches a reader (see Fig. 1) for chip card (see Fig. 1, "50","60"). The reader includes a central processing unit (see col. 7, line 44) for emitting (see Fig. 1, "10") and receiving (see Fig. 1, "5"). This communication is in a format determined by ISO 7816 protocol (see col. 8, lines 39-40) for contact chip card. The reader found in the prior art teaches a card-receiving device (see Fig. 1, "DR") including a contact card connector (see col. 7, lines 65-66) connected to the CPU (see Fig. 1, "2"). It is also disclosed a reading device for contactless chip cards including an interface (see col. 8, lines 52-54; Fig. 2, "82"). The interface for the contactless reading device is directly connected to a communication bus (see Fig. 2). The contactless reading device is arranged in hardware (see Fig. 2) and software (see col. 8, line 62). However, the reference does not explicitly disclose a communication bus. Nonetheless, Fig. 1 teaches emitting and receiving data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the elements in Fig. 1 via a communication bus, since it well known in the art the use of a bus for transmission and reception purposes. Although the reference does not expressly teach the emission or reception of binary messages, one of ordinary skill in the art at the time the invention was made would have applied the reference to binary data. Transmission and reception of binary messages is well known in the art. In addition, the reference does not teach a specific contact chip card activation command or a specific

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activation command. Nonetheless, the prior art teaches the activation of the contact chip card reading device and contactless card reading device. The reference also teaches responding to the activating instructions (see Figs 3, 5; col. 9, lines 1-5, 37-40). The contact and contactless chip cards respond only to their activation signals and devices, and not to the signal and devices intended to activate the other chip card type. In addition, Berger et al. teaches a chip card system having automatic recognition of the card modes (see col. 4, lines 17-29). The chip card system disclosed by Berger et al. teaches a response to a specific activation command (see col. 4, line 21) for a contactless card. This command is different from the activation command for the contact chip card. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both references in order to have a chip card reader that automatically recognizes a contactless chip card, according to an AC voltage (see Berger et al., col. 4, line 22).

As for claim 3, the combination of Timson et al. and Berger et al. does not explicitly teach an inhibition state for the card reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device not activated unless a signal is received.

As for claim 4, the combination of Timson et al. and Berger et al. teaches a central processing unit (see Timson et al.; Fig. 1, "2"). The CPU controls the card detection and

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activation commands (see col. 8, line 7). Nonetheless, the references do not explicitly disclose the specific operations performed by the CPU (see col. 9, lines 3-4). However, the CPU controls the contact card activation and communication with it (see Fig. 3, "92"; col. 9, lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to control, as disclosed, the contact card, an activation command must have been sent and a response would have been received. Accordingly, the CPU controls the contactless card activation and its communication with the processing unit (see Fig. 3, "92"; col. 8, lines 52-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made that in order to control, as disclosed, the contactless card, an activation command must have been sent and a response would have been received.

As for claim 5, Timson et al. does not disclose the contact card activation command as a reset command according to the ISO 7816 standard. Nonetheless, Berger et al. discloses an activation signal for a contact card mode (see col. 3, line 51). This activation signal is a reset signal (see col. 3, lines 43, 47-48). This command is in accordance to the ISO 7816 standard (see col. 4, line 2).

As for claim 6, the limitation of the specific activation command for the contactless card "likely to be never sent to a contact chip card" is taught by the combination of Timson et al. and Berger et al. In the combination of references, the detection and activation devices for both card types are different and separated (see Figs. 1, 2, 3; col. 8, lines 52-57).

As for claim 7, the limitation of “the specific activation command is a signal sent on a bus, which is not used by contact ship cards”, is taught by the combination of Timson et al. and Berger et al. The combination of references teaches detection and activation devices for both card types as different and separate (see Figs. 1, 2, 3; col. 8, lines 52-57).

As for claim 9, the combination of references teaches the contactless reading device as integrated in a circuit arranged inside the card-receiving device (see Timson et al., Fig. 1, “DR”; see Fig. 2, “82”).

As for claim 13, the combination of Timson et al. and Berger et al. does not expressly disclose an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Timson et al., Fig. 2, “82”; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device not activated unless a signal is received. Accordingly, a return to the inhibition state would have been defined when the activation signal is not received on the interface disclosed by Timson et al.

12. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timson et al. [US 6,041,412].



Regarding claim 10, Timson et al. discloses a reading device for contactless chip cards including an interface (see col. 8, lines 52-54; Fig. 2, "82"). The interface for the contactless reading device (read head) is directly connected to a communication bus for receiving or emitting messages (see Fig. 2). This communication is in a format determined by ISO 7816 protocol (see col. 8, lines 39-40). However, the prior art does not explicitly teach an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art that the contactless reading device is in inhibition state when the activation command is not received, since the reading device is not activated unless a signal is received.

As for claims 11 and 12, the contactless card responds only to the specific activation command (see Figs. 1, 2, 3; col. 8, lines 52-57). The reference does not explicitly teach an inhibition state for the reader. Nonetheless, the contactless reading device is not activated unless a specific command is received (see Fig. 2, "82"; col. 8, lines 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made, that the contactless reading device is in inhibition state when the activation command is not received, since the reading device not activated unless a signal is received.

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13. Claim 2 is rejected under 103 as being unpatentable over Timson et al. [US 6,041,412] in view of Berger et al. [US 6,168,083 B1], in further view of Hohle et al. [US 6,101,477].

As for claim 2, the combination of Timson et al. and Berger et al. does not explicitly teach a supply wire "Vcc". However, Hohle et al. teaches electrical supply for a contactless reading device by a supply wire (Vcc) (see col. 3, lines 5-9). This supply is in accordance to the ISO 7816 protocol (see col. 3, line 8). It would have been obvious to combine the cited references, since as it is well known in the art, the ISO 7816 protocol defines the positions and shapes of the electrical connectors for a chip card. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the chip card reader disclosed by Timson et al. and modified by Berger et al. is electrically supplied by a supply wire.

14. Claims 8 and 14 are rejected under 103 as being unpatentable over Timson et al. [US 6,041,412] in view of Berger et al. [US 6,168,083 B1], in further view of Colnot [US 5,613,159].

As for claim 8, the reader disclosed by Timson et al. and modified by Berger et al. does not explicitly teach converting messages from a first format into a second format. It should be acknowledged, nonetheless, that Timson et al. does teach a communication protocol (see col. 8, lines 39-40). It is well known in the art that the ISO 7816 standard defines the format of

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commands sent to a chip card and the returned responses from it. Colnot teaches a chip card device where a communication protocol determines (see col. 5, line 38) converting received messages received with a first format into messages in a second format (see col. 3, lines 61-64; col. 4, lines 13-16). It would have been obvious to modify the previous combination of references, since Colnot applies the format conversion to a contactless reading device.

As for claim 14, the reader disclosed by Timson et al. as modified by Berger et al. does not teach converting received messages from a first format into a second format. Nonetheless, it should be pointed that Timson et al. does teach a communication protocol (see col. 8, lines 39-40). It is well known in the art that the ISO 7816 standard defines the format of commands sent to a chip card and the returned responses from it. Accordingly, Colnot teaches a chip card device where a communication protocol determines (see col. 5, line 38) converting received messages received with a first format into messages in a second format (see col. 3, lines 61-64; col. 4, lines 13-16). It would have been obvious to modify the previous combination of references, since Colnot applies the format conversion to a contactless reading device, in order to obtain a read head that applies the automatic conversion for contactless chip cards. In addition, the prior art teaches the activation of the contact chip card reading device and contactless card reading device. The reference also teaches responding to these instructions (see Figs 3, 5; col. 9, lines 1-5, 37-40). The contact and contactless chip cards respond only to their activation signals and devices, and not to the signal and the devices intended to activate the other chip card type. Berger et al. teaches a chip card system having automatic recognition of the card mode (see col. 4, lines 17-29).

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The chip card system disclosed by Berger et al. teaches a response to a specific activation command (see col. 4, line 21) for contactless card. This command is different from the activation command for the contact chip card. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the references in order to have a chip card reader that automatically recognizes a contactless chip card, according to an AC voltage (see Berger et al., col. 4, line 22).

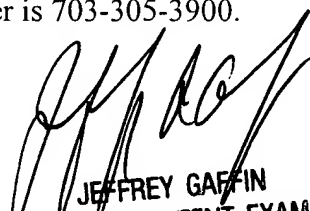
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 830-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

alc  
May 2, 2003

  
JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
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